

REMARKS/ARGUMENTS

Claims 1-18 are pending in the application. Claims 1-16 are rejected. Claims 17 and 18 are withdrawn from consideration.

By the present amendment claims 5, 10, and 11 have been cancelled. Claims 1, 2, 9, 12 and 13 have been amended.

The examiner has required restriction between product claims and process claims. Applicants hereby elect the claims directed to the product for prosecution in the present application. This election is made with traverse. Applicants acknowledge the fact that only process claim 16 along with the remaining claims, i.e. claims 1-15, are being examined and that process claims 17 and 18 have been withdrawn from consideration.

Claims 9-12 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claim 9 is regarded as being incomplete as written since it relies on the specification to define the claimed subject matter. By the present amendment claim 9 has been amended by deleting the compound numbers and inserting the name and structure of 28 compounds falling within the scope of claim 1 as amended. The 28 compounds correspond to compound numbers 4, 306, 71, 72, 31, 219, 218, 32, 321, 308, 393, 313, 164, 318, 287, 267, 317, 331, 286, 366, 269, 281, 285, 270, 258, 259, 253 and 408 all of which are disclosed in Tables 1, 4, 5 and 6 in the specification.

The examiner has stated that claims 10 and 11 do not further limit the scope of claim 1. To expedite prosecution claims 10 and 11 have been cancelled. Applicant's reserve the right to pursue the subject matter of these cancelled claims in a continuation or subsequent application.

The examiner has indicated that claim 12 is unclear as to what method/process applicant is intending to encompass. Claims 12 and 13 have been amended to read on a method of treating tachykinin mediated conditions.

In view of the amendments to the claims, reconsideration of the rejection of claims 9 and 12 under 35 U.S.C. §112, first paragraph, is courteously requested.

Claim 12 is rejected under 35 U.S.C. §101 on the ground that the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process. As indicated above, claim 12 has been amended to read on a method of treating tachykinin mediated conditions.

In view of the amendments to claim 12, reconsideration of the rejection of claim 12 under 35 U.S.C. §101 is courteously requested.

The examiner has indicated that the incorporation of subject matter by reference to WO publications into the application is ineffective because the publications are being relied on for the preparation of early starting materials. Although reference is made to certain publications which describe methods for preparing certain materials employed in applicants' invention, applicants wish to point out that the actual starting materials used in the invention are described in the specification on pages 29-40. The preparation of intermediate compounds corresponding to compound (XI) is found on pages 29-31 of the specification. Compound (XII) is 1-(phenylmethyl)piperazine. (See prep. of intermediate compound 3 on page 30 of the specification wherein "W" in compound (XII) is benzyl.)

Claim 1-16 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The examiner has concluded that the specification improperly incorporates essential material for the preparation of the instant compound. As indicated above, the preparation of the starting materials is described in

the specification on pages 29-40. The material deemed to be improperly incorporated in the specification has been deleted from the specification.

Reconsideration of the rejection of claims 1-16 under 35 U.S.C. §112, first paragraph, is courteously requested.

Claims 1-8 and 10-16 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enabling requirement. The examiner has concluded that the specification is not enabled for the scope of the compounds being claimed which includes an assortment of Het rings at R² coupled with varying ring sizes of both azene rings. The examiner has further concluded that compounds made and tested represent the scope of claim 9 which always have as R² an aryl ring with a piperidino-piperazino link. To expedite prosecution R² has been amended to read only on Ar², thus eliminating the various Het groups objected to by the examiner. Applicants reserve the right to pursue this subject matter in a subsequent patent application.

In view of the amendments to the claims, reconsideration of the rejection of claims 1-8 and 10-16 under 35 U.S.C. §112, first paragraph, is courteously requested.

The examiner has objected to the breadth of the claims. To expedite prosecution claim 1 has been amended by limiting the definition of n, m, q, Q, X and R² and deleting Het¹. Claim 2 has been amended by deleting the definition of n, m, p, q, Q and X, R² has been limited to Ar² and Het¹ has been deleted. Claim 5 has been cancelled as a result of the amendments made to claim 1. Again applicants reserve the right to pursue the cancelled subject matter in a subsequent patent application.

In view of the amendments to the claims, reconsideration of the claims is courteously requested.

The examiner has pointed out that the art cited in applicants' European Search Report has been reviewed but no claims have been rejected thereover. The examiner has also indicated that, in the event no IDS is furnished by applicant, the references cited in the Search Report will be made of record. Applicants are not aware of any references relevant to the claimed invention besides those cited in the specification and in the European Search Report. Applicants have submitted with this amendment a copy of an IDS setting forth the references cited in the Search Report and two additional references cited in the Background of Prior Art on page 6 of the specification.

In view of the above remarks it is believed that all of the outstanding objections and rejections have been overcome.

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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